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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/541,386	07/01/2005	Bernd Muller	5000-0128PUS1	6302
2292	7590	01/10/2008	EXAMINER	
BIRCH STEWART KOLASCH & BIRCH PO BOX 747 FALLS CHURCH, VA 22040-0747				BALASUBRAMANIAN, VENKATARAMAN
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE			DELIVERY MODE	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No.	Applicant(s)	
	10/541,386	MULLER ET AL.	
	Examiner	Art Unit	
	/Venkataraman Balasubramanian/	1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 25 October 2007.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-8 and 11-16 is/are rejected.
- 7) Claim(s) 9 and 10 is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____ . |

DETAILED ACTION

Applicants' response, which included addition of new claims 11-16 and amendment to claims 1, 2, 5, and 7, filed on 10/25/2007, is made of record. Claims 1-16 are now pending. In view of applicants' amendment, the 112 second paragraph rejections and 103 rejection over Heinmann et al., made in the previous office action have been obviated. However, prior art 103 rejection over Tanimoto et al., is maintained and new ground of rejection necessitated by the amendment is made.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 8 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. Claim 8 is an improper dependent claim as it fails to further limit the currently amended claim 1. Note the definition of R² is broader scope than the currently amended claim 1.
2. Similarly, claim 13 is an improper dependent claim as it fails to further limit claim 1 on which it is dependent. The original claim 1 and currently amended claim 1 do not have C₁-C₆-haloalkyl choice and hence the scope of claim 13 is outside the scope of claim 1.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-8 and 11-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tanimoto et al., US 6,562,817.

Tanimoto et al., teaches several tricyclic compounds for use in organ transplant, which include instant compounds. See column 1, formula I and note the definition of

various variable groups A, B C, X-Y V¹ and V². Also see column 13, formula I and column 14 for B ring definition which include pyrimidine. Note with the given definition of various variable groups, the compounds taught by Tanimoto et al. include instant compounds. Specifically, in formula I, B ring is pyrimidine, C ring a heterocycle, A ring is phenyl, X –Y is O-alkyl, O-alkenyloxy and others, the compounds taught by Tanimoto et al., include instant compounds. See entire document. Especially see column 109 for various A ring definitions and note X-Y can be allyloxy group. See also column 115 and note B ring choice S₃ is a pyrimidinyl group as required by instant claims. Also note S₁ is pyridinyl group. See column 150-151, Table 86 for pyridine and pyrimidine compounds.

Tanimoto et al. differs from the instant claims in exemplifying pyrimidine compounds having O-benzyl group for X-Y and other groups hydroxy, sulfonyl etc as substituents for in the phenyl ring. However, Tanimoto et al. when B=S₁, namely pyridine ring, teaches allyloxy group for X-Y.

In addition, Tanimoto teaches equivalency of those compounds taught in Table 86 those generically recited in column 1-14.

Thus, it would have been obvious to one having ordinary skill in the art at the time of the invention was made to make compositions using the teachings of Tanimoto et al., including phenyl ring bearing substituents corresponding to instant compounds and expect resulting composition to possess the uses taught by the art in view of the equivalency teaching outline above.

This rejection is same as made in the previous office action but now includes newly added claims 11-16.

Applicants' argument to overcome this rejection is not persuasive.

Applicants argued that the use of compounds as pharmaceuticals taught by Tanimoto is different from instant fungicidal use. But a compound is a compound and use of the compound for different purposes does alter its structural make-up. In addition the rejection is applied to only compound claims not to method of use claims. One trained in the art would be motivated to make the compounds of Tanimoto for the use taught therein. Tanimoto as noted above teaches a genus of compounds, exemplifies large number compounds including those with allyloxy substituents, and thereby provides guidance for choosing substituents. Thus, there is motivation to make the compounds of the genus as one would expect the genus would share the same use as those exemplified compounds. Hence, teaching suggestion and motivation requirements are clearly met with. Hence, *In re Vaeck* cited by the applicants is not the point. In *KSR International Co. v. Teleflex Inc.*, 127 S.Ct. 1727 (2007), the court stated that

[w]hen there is a design need or market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp. If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense.

Such is the case with Tanimoto. Teaching and suggestion variable groups and those exemplified compounds would lead one of ordinary skill to make the said compounds for the use taught therein. Again, it is not *In re Baird* situation as the core

compound is taught with only variation in substitution and that there is adequate guidance provided by Tanimoto to have allyloxy group for X-Y. In this regard applicants should note *In re Bruckel*, 201 USPQ 67., “ References must be considered under 35 U.S.C 103, not only for what it expressly teaches but also for what it fairly suggests; all disclosures of prior art, including unpreferred embodiments must be considered in determining obviousness”.

As noted above, based on the generic teachings and the equivalency teaching of the exemplified compounds with those generically claimed, one trained in the art would be motivated to make compounds of the genus of Tanimoto et al., and expect resulting compounds (instant compounds) to possess the uses taught by the art in view of the equivalency teaching outline above. Hence, this rejection is proper and is maintained.

Allowable Subject Matter

Claims 9 and 10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication from the examiner should be addressed to Venkataraman Balasubramanian (Bala) whose telephone number is (571) 272-0662. The examiner can normally be reached on Monday through Thursday from 8.00 AM to 6.00 PM. The Supervisory Patent Examiner (SPE) of the art unit 1624 is James O. Wilson, whose telephone number is 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned (571) 273-8300. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAG. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you

have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-2 17-9197 (toll-free).

/Venkataraman Balasubramanian/

Primary Examiner, Art Unit 1624

1/7/2008